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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,578	05/10/2001	Hirokazu Uchio	B422-149	5069

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EXAMINER	
NGUYEN, CHAU T	
ART UNIT	PAPER NUMBER
2176	
MAIL DATE	DELIVERY MODE
02/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/852,578	UCHIO ET AL.	
	Examiner	Art Unit	
	CHAU NGUYEN	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *1-15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Notice to Applicant

1. This action is responsive to amendment filed on 12/06/2007.

2. Claims 1-30 are currently pending. Claims 1-15 are withdrawn. Claims 16, 21, 22, 23, 29, and 30 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 23-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 23-28 recite "an information processing apparatus", which is computer software per se because the body of the claims 23-29 does not recite hardware. Therefore, claims 23-29 do not recite statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 23 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwai et al. (Iwai), U.S. Patent No. 5,175,681.

8. Regarding independent claims 23 and 29-30, Iwai discloses: An information processing apparatus for managing a document related to technical information (see Title and Abstract), comprising:

a first determination means for determining whether oversea transmission of said technical information is restricted based on whether a predetermined period has passed from filing (see col. 2, lines 54-63: The second memory defines rules of law for processing a patent application overseas; col. 17, lines 26-36: the rule data file further includes the time-control table (predetermined period) storing data necessary for setting the due date (from filing) according to the laws and rules in respective countries (overseas) to file the application, i.e., in United Kingdom Patent applications, extensions extension of Response periods are generally not available, therefore, the due date for responding or transmitting to the subject office action (from USPTO) is 3 months since the filing/filing receipt of the subject office action (from USPTO), and the extension time is none for overseas (col. 23, lines 42-51));

second determination means for determining whether overseas transmission of said technical information is restricted based on whether a predetermined permission has been obtained (col. 17, lines 26-36: establishing a plurality of tables for performing time control in respective countries such as determining if application is filed from US or from United Kingdom (oversea), if the application is United Kingdom Patent application,

extensions extension of Response periods are generally not available, therefore, the due date for responding or transmitting to the subject office action (from USPTO) is 3 months since the filing/filing receipt of the subject office action (from USPTO), and the extension time is none for overseas (col. 23, lines 42-51)); and

control means for controlling overseas transmission of said document depending on a determination result by said determination means (see col. 2, lines 29-35: The data memory that stores the rules also controls the output of the technical information, the rules data include information concerning required actions at each step of the prosecution of the application in each country where the application are filed).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwai et al. (Iwai), U.S. Patent No. 5,175,681 and further in view of Revette et al. (Revette), US Patent No. 5,991,751.

11. Regarding independent claim 16, Iwai discloses:
An information processing apparatus for processing electrical data sent from Patent Office, the electrical data including a first portion relating to a document issued at Patent

Office and a second portion relating to an application number of the document, comprising:

first storage means for storing a reception record of the document received from Patent Office (see col. 3 lines 3-8 and col. 8, lines 38-63: A first memory constitutes a master file that is divided into a plurality of unit memory blocks one of which stores a transmission/reception record of an application received by the Patent Office (i.e., filing date, publication date, issue date, etc.);

second storage means for storing document data of said document (see Fig. 1; col. 5, lines 1-29; col. 8, lines 32-63; col. 19, line 65 to col. 20, line 26; col. 22, lines 55-61: The master file, case file, and document data file memory blocks all store document data of said document);

acquisition means for acquiring the application number from the reception record stored in said first storage means or the document data stored in said second storage means (see col. 2, lines 47-67 et seq. and col. 19 line, 42 to col. 20, line 20; col. 24, lines 64-67: An application number is acquired from the record stored in the master, case, or document data file by referring to a database table);

a table storing data showing correspondence between the application number and an applicant (see col. 8, lines 45-56: a storage for storing basic or fundamental data of an individual application, such as name of inventor (applicant) and application number, filing date, etc…);

and extraction means for extracting document data of the document stored in said second storage means and related to said application number by referring to said

table using the application number obtained by said acquisition means as a key (see col. 3, lines 12-63; col. 19, line 43 to col. 20, line 17; col. 25, line 60 to col. 26, line 22: The second memory comprises a rule table that controls the processing of applications throughout prosecution of the application that includes the correspondence between an application number and applicant found in the other memory blocks).

However, Iwai does not explicitly discloses extracting, for a plurality of different applicants, document data of the document stored in said second storage means and related to said application number, and third storage means for storing extracted document data in relation to bibliographic data corresponding to the application number and the application.

In the same field of endeavor, Rivette discloses patent bibliographic data includes information such at patent number, the issue date, the inventors (applicants), the title, serial number, filing data, etc... (col. 17, lines 55-66). Rivette further discloses a patent bibliographic file is generated or extracted from a patent text file, and the patent bibliographic file includes patent bibliographic information (col. 66, lines 45-52). Rivette further discloses in col. 18, lines 8-15 that the patent bibliographic databases 604 (third storage means) store bibliographic information on all US Patents (a plurality of different applicants) or store patent bibliographic information on a subset of all U.S. patents such as all U.S. patents that are available in electronic form from U.S Patent Office or all U.S. patents that issued after a certain date.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rivette with Iwai to include extracting,

for a plurality of different applicants, document data of the document stored in said second storage means and related to said application number, and third storage means for storing extracted document data in relation to bibliographic data corresponding to the application number and the application. Rivette suggests that the document storage in combination with the patent bibliographic database provide the customer with the ability to quickly, efficiently, and effectively access, display, and process any patent of interest.

12. Regarding claim 17, Iwai discloses holding means for holding the document data extracted by said extraction means in a holder for each applicant (see col. 19, line 43 to col. 20, line 17).

13. Regarding claim 18, Iwai discloses transmission means for transmitting the document data held in said holder to a corresponding applicant (see col. 24, lines 15-67 et seq.).

14. Regarding claim 19, Iwai discloses printing means for printing the document data held by said holder by applicant (see col. 26, lines 12-17).

15. Regarding claim 20, Iwai discloses wherein said data stored in said table indicates an applicant of an application corresponding to said application number (see col. 19, lines 43-60).

16. Independent claims 21 and 22 incorporate substantially similar subject matter as claim 16, and are rejected along the same rationale.

7. Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwai et al. ("Iwai"), U.S. Patent No. 5,175,681, in view of Lee, U.S. Patent No. 7,016,851.

17. Regarding claims 24 and 28, Iwai discloses an information processing apparatus for managing a document related to technical information as discussed in independent claim 23 above, but does not explicitly disclose wherein said document is transmitted as electronic data through a network overseas.

However, Lee discloses a patent application being transmitted overseas as electronic data through a network (see Abstract and col. 7, lines 54-67). Since both references are from the same field of endeavor, the motivational purpose of preparing intellectual property filings in accordance with jurisdiction specific requirements as disclosed by Lee would have been recognized in the pertinent art of Iwai. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of Iwai with the teachings of Lee to include a patent application being transmitted overseas as electronic data through a network.

18. Regarding claim 25, Iwai discloses wherein said determination means determines the rule based on a filing date of said patent application (see col. 2, lines 54-

63: The second memory defines rules of law for processing a patent application overseas).

19. Regarding claim 26, Iwai discloses wherein said determination means determines the rule based on a flag stored in a server for managing said document (see col. 12, lines 44-64 and col. 16, lines 39 et seq.).

8. Regarding claim 27, Iwai discloses wherein said determination means determines the rule based on a flag stored in a server for managing said document (see col. 12, lines 44-64 and col. 16, lines 39 et seq.), but does not explicitly discloses wherein said flag indicates whether or not a license has been acquired.

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a flag to indicate whether or not a license has been acquired for the motivational purpose of ensuring that permission has been granted to use the particular method and system.

Response to Arguments

In the remarks, Applicant(s) argued in substance that

A) Prior art does not teach or suggest processing electrical data sent from Patent Office, electrical data including a first portion relating to a document issued at Patent Office and a second portion relating to an application number of the document (see page 13 of remarks).

In response to applicant's arguments, the recitation "electrical data sent from Patent Office, electrical data including a first portion relating to a document issued at Patent Office and a second portion relating to an application number of the document" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In this case, Iwai discloses storage for storing basic or fundamental data of an individual application such as application number, filing date, publication number, patent number, issue date and so forth (col. 8, lines 44-63). Thus, application number, publication number, patent number, and issue date must come from Patent Office. Also the storage stores a brief summary of the invention and a typical drawing of the subject matter of the invention which relate to patent applications or patent issued at the Patent Office (col. 8, lines 38-67).

B) Prior art does not disclose or suggest extracting, for a plurality of different applicants, document data of the document stored in the second storage means and related to the application number (see page 13 of remarks).

Applicant's arguments with respect to amended limitation “extracting, for a plurality of different applicants, document data of the document stored in the second storage means and related to the application number” have been considered but are moot in view of the new ground(s) of rejection, under Iwai in view of Revette. Please see the rejection above.

C) Prior art does not disclose or suggest “determining whether overseas transmission of technical information is restricted based on whether a predetermined period has passed from filing and based on whether a predetermined permission has been obtained and controlling overseas transmission of the document based on the determinations."

In reply to argument C, Iwai discloses determining whether oversea transmission of said technical information is restricted based on whether a predetermined period has passed from filing (see col. 2, lines 54-63: The second memory defines rules of law for processing a patent application overseas; col. 17, lines 26-36: the rule data file further includes the time-control table (predetermined period) storing data necessary for setting the due date (from filing) according to the laws and rules in respective countries (overseas) to file the application, i.e., in United Kingdom Patent applications, extensions extension of Response periods are generally not available, therefore, the due date for responding or transmitting to the subject office action (from USPTO) is 3 months since

the filing/filing receipt of the subject office action (from USPTO), and the extension time is none for overseas (col. 23, lines 42-51));

determining whether overseas transmission of said technical information is restricted based on whether a predetermined permission has been obtained (col. 17, lines 26-36: establishing a plurality of tables for performing time control in respective countries such as determining if application is filed from US or from United Kingdom (oversea), if the application is United Kingdom Patent application, extensions extension of Response periods are generally not available, therefore, the due date for responding or transmitting to the subject office action (from USPTO) is 3 months since the filing/filing receipt of the subject office action (from USPTO), and the extension time is none for overseas (col. 23, lines 42-51)).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The examiner can normally be reached on 8:30 am – 5:30 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton, can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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